

## **REMARKS/ARGUMENTS**

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow. Claims 12, 17, and 18 are currently being amended. Claim 28 is being added. Applicant respectfully submits that the claim amendments and newly added Claim 28 do not introduce new subject matter into the present application. After amending the claims as set forth above, Claims 12, 17, 18, and 20-28 are now pending in this application.

### **I. Claim Rejections Under 35 U.S.C. § 103(a)**

In Section 2 of the Office Action, Claims 12, 17, 18, 21, and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 343,688 to Barney (hereinafter "Barney") in view of U.S. Patent No. 4,538,430 to Parks (hereinafter "Parks"). Applicant respectfully traverses the rejections.

#### **A. Claim 12**

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." See MPEP § 2143.03 and *In re Royka*, 490 F.2d 981 (CCPA 1974). Applicant respectfully submits that, alone or in combination, Barney and Parks do not disclose "at least one spacer, whereby the collar is adapted to fit around necks of beverage decanters having differing diameters by trimming the at least one spacer," as required by independent Claim 12. (Emphasis added). In Section 3 of the Office Action, the Examiner acknowledges that "Barney does not teach the collar having a spacer." In Section 4 of the Office Action, the Examiner goes on to state that "Parks teaches a collar/ring 15 having a spacer 10 ...." As discussed in Applicant's Amendment and Reply dated August 15, 2006, Applicant respectfully disagrees.

In addition, Applicant respectfully submits that Parks does not disclose a "spacer ... whereby the collar is adapted to fit ... differing diameters by trimming the ... spacer," as required

by Claim 12. Parks discloses “[a] ring sizing insert” which is “snapped into gripping engagement with a ring shank.” (Abstract). Parks does not teach, suggest, or describe “trimming” or in any other way modifying the ring sizing insert such that fingers of “differing diameters” may wear a given ring. The insert disclosed in Parks is a fixed insert which can be used to allow a finger of a given diameter to fit better into a ring. If the diameter of the finger is too large or too small, the insert disclosed in Parks is ineffective because said insert is not adjustable. Further, Applicant respectfully submits that neither Parks nor Barney teach, suggest, or describe “beverage decanters,” or a collar which “is adapted to fit around necks of beverage decanters,” as required by Claim 12.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of Claim 12.

B. Claim 17

Applicant respectfully submits that, alone or in combination, Barney and Parks do not disclose “a collar ... adapted to fit around a neck of a beverage decanter” or a “collar [which] is adapted to closely fit around a tapered neck of a beverage decanter,” as required by Claim 17. (Emphasis added). As discussed above, Parks discloses “[a] ring sizing insert” which is “snapped into gripping engagement with a ring shank.” (Abstract). The only “collar” disclosed in Parks is a jewelry ring adapted to fit around the finger of a person. Barney discloses “a napkin-ring” (line 11) including “a slip of paper ... for the purpose of identifying the napkin which is inclosed (sic) in the ring.” (Lines 12-16). Thus, the “collar” disclosed in Barney is a napkin ring adapted to fit around a napkin. Applicant respectfully submits that a finger and a napkin are entirely different than a “beverage decanter.” Neither Barney nor Parks teach, suggest, or describe “beverage decanters,” or a collar which “is adapted to fit around a neck of a beverage decanter,” as required by Claim 17.

In addition, Applicant respectfully submits that, alone or in combination, Barney and Parks do not disclose a collar which “has an upper surface that includes at least one recessed

area” such that “the collar is adapted to closely fit around a tapered neck of a beverage decanter,” as required by Claim 17. (Emphasis added). As discussed above, the collar disclosed in Parks is a jewelry ring adapted to fit around the finger of a person, and the collar disclosed in Barney is a napkin ring adapted to fit around a napkin. Parks does not teach, suggest, or describe a jewelry ring in which the “upper surface ... includes at least one recessed area,” as required by Claim 17. Similarly, Barney does not teach, suggest, or describe a napkin ring in which the “upper surface ... includes at least one recessed area,” as required by Claim 17. Further, neither Parks nor Barney disclose a “collar” which “includes at least one recessed area” such that “the collar is adapted to closely fit around a tapered neck of a beverage decanter,” as required by Claim 17.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of Claim 17.

C. Claim 18

For at least the reasons discussed with reference to Claim 17, Applicant respectfully submits that, alone or in combination, Barney and Parks do not disclose a “collar [which] is adapted to fit around a neck of a beverage decanter,” as required by Claim 18. (Emphasis added). In addition, for at least the reasons described with reference to Claim 12, Applicant respectfully submits that neither Barney nor Parks teach, suggest, or describe a “collar [which] is adapted to fit around necks of beverage decanters having differing diameters by trimming the at least one spacer,” as required by Claim 18. (Emphasis added).

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of Claim 18.

D. Claims 21 and 23

Applicant respectfully submits that, alone or in combination, Barney and Parks do not disclose “a collar ... adapted to fit on a neck of a beverage decanter,” as required by

Claim 21. (Emphasis added). As discussed above, the collar disclosed in Parks is a jewelry ring adapted to fit around the finger of a person. The collar disclosed in Barney is a napkin ring adapted to fit around a napkin. Neither a jewelry ring nor a napkin ring is or can be “adapted to fit on a neck of a beverage decanter,” as required by Claim 21.

For at least these reasons, Applicant respectfully requests withdrawal of the rejection of independent Claim 21, and Claim 23 which depends from Claim 21.

E. The Examiner has Provided an Improper Motivation to Combine Barney and Parks

“Obviousness can only be established by combining ... the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so.” See MPEP § 2143.01 and *In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006). Applicant respectfully submits that the Examiner has provided no teaching, suggestion, or motivation to combine Barney and Parks. In Section 5 of the Office Action, the Examiner states that:

“It would have been obvious to one having ordinary skill in the art at the [time] this invention was made to construct the collar/ring taught by Barney with a spacer as taught by Parks to provide a means to adjust the interior diameter or size of the ring/collar.”

Applicant respectfully disagrees.

If a jewelry ring is able to slide off a finger, the wearer can lose the ring (and its monetary value). Thus, it is desirable for a jewelry ring to fit snugly and it makes sense to have a jewelry ring insert to facilitate a snug fit. On the other hand, if a napkin fits snugly within a napkin ring, a user of the napkin may have to struggle to disengage the napkin therefrom. Thus, it would be undesirable to use an insert to decrease the inside diameter of a napkin ring. Applicant respectfully submits that the “proposed modification would render the prior art invention [in Barney] being modified unsatisfactory for its intended purpose” and that as a result “there is no suggestion or motivation to make the proposed modification.” MPEP § 2143.01.

In addition, a napkin, unlike a finger, is composed of paper or other material which can easily be fluffed or compressed such that any napkin can be made to fit within virtually any sized napkin ring. Also, unlike a finger which is constantly moving and subject to sweat, a napkin is a stationary object which is unlikely to 'lose' its napkin ring. Therefore, it is unnecessary to decrease the inside diameter of a napkin ring and it is unclear why anyone would be motivated to do so.

For at least these reasons, Applicant respectfully submits that the Examiner has provided an improper motivation to combine Barney and Parks and respectfully requests withdrawal of the rejections under 35 U.S.C. § 103(a).

F. Barney and Parks are Non-Analogous Art

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." See MPEP § 2141.01(a) and *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992). Applicant respectfully submits that neither Barney nor Parks are analogous art.

Applicant's field of endeavor is "beverage merchandising." (Title). Barney is directed toward the field of napkin rings, napkins, or possibly place settings. Parks is directed toward the field of jewelry as indicated by the classification (63: jewelry) assigned to Parks by the United States Patent & Trademark Office. For at least these reasons, Applicant respectfully submits that neither Barney nor Parks is in the field of Applicant's endeavor.

The particular problem with which Applicant is concerned is merchandising beverages on a beverage decanter. (Abstract). The particular problem with which Barney is concerned is "to produce a napkin-ring so formed and arranged that the name of a person written or marked on a slip of paper ... can be readily and conveniently placed thereon for the purpose of identifying the napkin which is inclosed (sic) in the ring." (Lines 10-16). Applicant respectfully submits that

the problem of identifying the napkin of an individual is not reasonably pertinent to the problem of merchandising beverages on a beverage decanter. Thus, Applicant respectfully submits that Barney is not analogous art because Barney is not in the field of Applicant's endeavor or reasonably pertinent to the problem with which Applicant is concerned. For at least these reasons, Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. § 103(a).

The particular problem with which Parks is concerned is "prevent[ing] rotation or other movements of the ring on the finger." (Abstract). Applicant respectfully submits that the problem of preventing the movement of a piece of jewelry is not reasonably pertinent to the problem of merchandising beverages on a beverage decanter. Thus, Applicant respectfully submits that Parks is not analogous art because Parks is not in the field of Applicant's endeavor or reasonably pertinent to the problem with which Applicant is concerned. For at least these reasons, Applicant respectfully requests that the Examiner withdraw the rejections under 35 U.S.C. § 103(a).

## **II. Allowable Subject Matter**

Applicant directs the Examiner to an apparent mistake in Section 6 of the Office Action in which the Examiner states that Claim 18 is allowed. Based on the Examiner's statements, Applicant understands that Claim 20, and not Claim 18, is allowed. The Examiner also stated, in Section 7 of the Office Action, that Claims 22, 24, and 25 are objected to as being dependent upon a rejected base claim. Applicant thanks the Examiner for noting the allowable subject matter. However, for the reasons discussed above, Applicant respectfully submits that each of the pending claims in the present application are in condition for allowance. Therefore, Applicant respectfully requests that the Examiner withdraw the objection to Claims 22, 24, and 25.

### III. Claims 26-28

In Applicant's Amendment and Reply dated August 15, 2006, Applicant added Claim 26 and Claim 27 to the present Application. The Examiner did not address Claims 26 or 27 in the present Office Action. For at least the reasons discussed above with reference to Claims 12, 17, 18, and 20-25, and for the reasons discussed below with reference to Claim 28, Applicant respectfully submits that Claims 26 and 27 are in condition for allowance.

Applicant has also added Claim 28 to the present application. Claim 28 requires "a collar adapted to fit on a neck of a beverage decanter, wherein the collar includes a gap capable of receiving a handle of the beverage decanter, and further wherein the collar includes an information display surface, wherein a lower lip is connected to a lower end of the information display surface and an upper lip is connected to an upper end of the information display surface." For at least the reasons discussed above with reference to Claims 12, 17, 18, and 20-25, Applicant respectfully submits that Claim 28 is in condition for allowance. In addition, Applicant respectfully submits that neither Barney nor Parks disclose "a collar" which "includes a gap capable of receiving a handle of the beverage decanter," as required by Claim 28. (Emphasis added). The collar disclosed in Barney is a fully annular, gapless napkin ring. (Figs. 1-2). The collar disclosed in Parks is a gapless jewelry ring. (Figs. 4-5.)

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

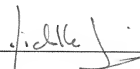
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-2350. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper

or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-2350. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-2350.

Respectfully submitted,

Date February 22, 2007

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